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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/659,703	09/11/2003	Kester J. Batchelor	2558-73	4755

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EXAMINER

NGUYEN, VI X

ART UNIT PAPER NUMBER

3731

DATE MAILED: 09/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/659,703

Applicant(s)

BATCHELOR ET AL.

Examiner

Victor X. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 09/03.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Double Patenting*

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-3 and 5-20 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3 and 5-19 of U.S. **Patent No.**

**6,827,725**. Although the conflicting claims are not identical, they are not patentably distinct from each other because they recite the same subject matters as following: a surgical instrument comprises an elongate hollow probe having an apertured region, an elongate drive shaft, a cutting tool, an electrosurgical device located at the distal end of the probe, a motor, and suction means for providing a source of suction at the apertured region for evacuating tissue debris removed by the cutting tool.

### *Specification*

2. The abstract of the disclosure is objected to because legal phraseology has been used. The legal term "comprising" was used in the abstract and correction is required. See MPEP § 608.01(b).

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4,6 and 19-20 are rejected under 35 U.S.C. 102 (b) as being anticipated by West, Jr (5,904,681).

West, Jr discloses as is claimed (Abstract, figures 2-6, col. 3 lines 59-65, col. 4 lines 1-27, col. 7 lines 55-67, col. 8 lines 1-65 and col. 9 lines 1-30) a surgical instrument (10); where an electrosurgical device (106) is a bipolar electrosurgical device (134) and including at least one active electrode, one return electrode (138) and an insulator (148), where the apertured region (figs 3-6) constituted with first and second apertures; where the cutting tool (130) can cut tissue and the cutting means being engageable with tissue through the apertures; where the drive shaft (132) is hollow, the cutting tool (130) is hollow and contiguous, and the distal end portion of the cutting tool (130) is formed through which tissue debris can be evacuated, where the blocking means (col. 4 lines 11-38) is provided by the cutting tool (130); where the cutting tool (130) provided with an abrasive outer surface, the probe (92) having an inlet through which tissue debris can pass; where there is a single active electrode, a single return electrode (138), the insulator (148) and the return electrode (138) are formed with contiguous apertures; and where the drive shaft (132) is solid and defined a channel between the drive shaft (132) and the hollow probe (92), where tissue debris can be removed by the channel.

***Claim Rejections - 35 USC § 103***

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4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5-9 and 17-18 are rejected under 35 U.S.C. 103 (a) as being unpatentable over West, Jr in view of Goble et al (U.S. 6,482,202).

With respect to claims 5-9 and 17-18, West, Jr discloses the invention substantially as claimed except the suction means for providing a source of suction at the apertured region for evacuating tissue debris removed by either the cutting tool or the electrosurgical device. Goble et al teaches the suction means for providing a source of suction at the apertured region for evacuating tissue debris removed by either the cutting tool or the electrosurgical device (figs 2, 5-6, col.4 lines 60-67, col. 5 lines 1-8, col. 6, lines 48-67 and col. 7 lines 1-7) in order to remove tissue particles and debris efficiently from the region surrounding the tissue treatment site. It would have been obvious to one of ordinary skill in the art at time of the invention to modify West, Jr by adding the suction means for providing a source of suction at the apertured region for evacuating tissue debris removed by either the cutting tool or the electrosurgical device in order to remove tissue particles and debris efficiently from the region surrounding the tissue treatment site.

### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor X. Nguyen whose telephone number is (571) 272-4699. The examiner can normally be reached on M-F (8-4.30 P.M).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anh Tuan Nguyen can be reached on (571) 272-4963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Victor X Nguyen  
Examiner  
Art Unit 3731

Vn VP  
9/6/2005



**JULIAN W. WOO**  
**PRIMARY EXAMINER**